

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES E. ROSS JR. and WILLIAM J. LYNCH

Application No.09/100,100

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences (BPAI) on March 16, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below:

(1) Appellants filed a Reply Brief on February 12, 2004 (Paper No. 33) in response to the Examiner's Answer entered December 16, 2003 (Paper No. 31).

Section 1208.03 of the Manual of Patent Examining Procedure (8th ed., Rev. 1, Feb. 2003) states:

Appellant may file a reply brief to an examiner's answer or a supplemental examiner's answer within 2 months from the date of such examiner's answer or supplemental examiner's answer. . . . The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. See also 37 CFR § 1.193. (emphasis added)

There is no indication on the record whether or not the examiner has responded to Appellants' Reply Brief.

(2) On page 9 of the Examiner's answer, the Examiner lists the references relied upon in support of his rejection of the claims on appeal. It is essential that the BPAI have a copy of the references relied upon by the Examiner, in formulating a decision on an appeal. The following listed reference is not found in the file:

Collen, Morris F., *Hospital Computer system*, John W. Wiley & Sons, 1974, p[p.] 94-104, 198-202.

Accordingly, it is

ORDERED that the application is being returned to the Examiner for the Examiner to:

- (A) issue a proper response in conformance with 37 CFR § 1.193
- (b)(1) to Appellants Reply Brief, filed February 12, 2004,
- (B) supply the BPAI with a copy of the missing references and
- (C) for such further action as may be appropriate.

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It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES

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